

REMARKS

In the present Application, Claims 29, 31, 32, 35, 37, and 38 have been amended. As such, Claims 29-41 are currently pending. The Examiner has presented the following objections and rejections:

- (I) The Examiner requested a status update to the priority claim;
- (II) Claims 29-41 were rejected under 35 U.S.C. 112, second paragraph, as allegedly indefinite;
- (III) Claims 29-34 were rejected under 35 U.S.C. 102(b) as allegedly anticipated in light of Chen et al. as evidenced by Kobayashi et al. and Altieri et al.; and
- (IV) Claims 35-41 were rejected under 35 U.S.C. 103(a) as allegedly obvious over Chen et al. as evidenced by Kobayashi et al. and Altieri et al., in view of Maniatis et al.

Applicants believe the following amendments and remarks traverse the Examiner's objections and rejections.

I. Status Update

The Examiner requested that the priority claim be updated to reflect the issuance of U.S. Pat. No. 6,709,861. Applicants have made this amendment.

II. The Claims are Definite

The Examiner rejected Claims 29-41 under 35 U.S.C. 112, second paragraph, as allegedly indefinite alleging that nothing in the claim fixes the position of the first and second ends, and as a result, the first and second ends could be anywhere within the nucleic acid sequence. (Office Action, page 3). Applicants disagree with this rejection. Nonetheless, for business reasons, in order to further the prosecution of the present Application, yet without acquiescing to any of the Examiner's rejections, while explicitly reserving the right to prosecute the original claims (or similar claims) in the future, Applicants have amended the claims. In particular, Applicants have amended Claims 29 and 35 to indicate that the nucleic acid has first and second ends, and that the nucleic acid sequence comprises the recited elements *between* the first and second ends of the nucleic acid sequence. Applicants submit that this amendment overcomes the Examiner's

rejection as the relationship of the recited elements to the ends of the nucleic acid is clear. As such, this rejection should be withdrawn.

The Examiner also rejected Claim 32 and 38 as allegedly indefinite for reciting that the selectable marker region comprises "first and second selectable marker sequences" asserting that this could be two domains of the same selectable marker or two separate genes. (Office Action, pages 3-4). Applicants respectfully disagree with this rejection. Nonetheless, for business reasons, in order to further the prosecution of the present Application, yet without acquiescing to any of the Examiner's rejections, while explicitly reserving the right to prosecute the original claims (or similar claims) in the future, Applicants have amended the claims. In particular, Claims 32 and 38 have been amended to recite first and second selectable marker *genes*, instead of sequences. As such, this rejection should be withdrawn.

III. Chen et al. Does Not Anticipate the Claims

The Examiner rejected Claims 29-34 under 35 U.S.C. 102(b) as allegedly anticipated in light of Chen et al. as evidenced by Kobayashi et al. and Altieri et al. (Office Action, pages 4-6). In particular, the Examiner cites the pJDC9 plasmid shown in Figure 2 of Chen et al. as teaching all the elements of Claims 29-34. The Examiner states that this plasmid anticipates the claims because the first and second ends could be located anywhere within the nucleic acid sequence (Office Action, page 5, lines 7-8; lines 12-14; and lines 18-19). While applicants disagree with the Examiner's rejection, it is noted that Claim 29 has been amended as discussed above to recite that the nucleic acid has first and second ends, and that the selectable marker region, origin of replication and first terminator are between these ends. As such, the pJDC9 plasmid cited by the Examiner does not anticipate these claims as the elements in this plasmid are not arranged as specified in amended Claim 29. For example, pJDC9 does not have a second transcriptional terminator between the toxic gene sequence and the first end of the nucleic acid sequence and a third transcriptional terminator between the toxic gene sequence and the second end of the nucleic acid sequence. Therefore, this rejection should be withdrawn.

IV. Chen et al. and Maniatis et al. Do Not Render the Claims Obvious

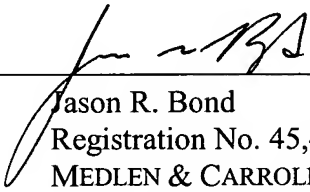
The Examiner rejected Claims 35-41 under 35 U.S.C. 103(a) as allegedly obvious over Chen et al. as evidenced by Kobayashi et al. and Altieri et al., in view of Maniatis et al. (Office

Action, pages 6-9). Applicants submit that this rejection is moot as Claim 35, like Claim 29, has been amended to specify that the nucleic acid has first and second ends, and that the selectable marker region, origin of replication and first terminator are between these ends. As such, the pJDC9 plasmid in Chen et al. fails to teach all the elements of Claims 35-41 (e.g., pJDC9 does not have transcriptional terminators between the toxic gene sequence and each end of the nucleic acid sequence). Maniatis does not cure these deficiencies. As such, the combination of Chen et al. and Maniatis does not render amended Claims 35-41 obvious. Therefore, this rejection must be withdrawn.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that Applicants' Claims, as amended, should be passed to allowance. If the Examiner wishes to discuss this case, Applicants encourage the Examiner to call the undersigned at 608-218-6900 at the Examiner's convenience.

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